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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,522

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 and 34-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 2 is objected to because of the following informalities:

Regarding claim 2, --trial-- needs to be inserted after "previous" in line 3.

Appropriate correction is required.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "means for determining" in line 8 of claim 9.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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Regarding claim 1, the limitation "determining whether or not the user has already performed a trial purchase procedure" lacks technology and merely states an abstract idea. This step in essence can be performed mentally or on paper. Based on the comments provided by the applicant, the applicant has stated that the means for determining is software. In order for the software to be useful, a computer or a database needs to be associated and recited. Alternatively put, in order for making the determination, a computer readable medium is required for the step to be useful.

Regarding claim 2, in order for storing a delivery destination, a database needs to be associated with this step as the step is not associated with any technology. One could as well noted on paper or mentally.

Regarding claims 3-8, the claims depend from claim 1 and therefore are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention.

Regarding claim 9, applicant has stated three different means for performing actions without specifying in the disclosure what the means comprise. In the first instance, the means for determining could as well be a person mentally doing the determination or something physical? The specification does not state what they are. Applicant has made a mere allegation that the journeyman programmer would be able to implement the means for determining from the disclosure and the flow chart. First of all, the flow chart shows steps in a process and not programming. How can step S18, in particular, be a program (the means for determining)? The examiner has considered the remark, on page 15 at the end of the second paragraph, that the structure would be imbedded in software. First of all, what structure is applicant referring to? There is nothing in the drawings that shows structure but logical steps. Based on the comments recited that the structure is embedded in software (see remarks on the second paragraph on page 15), or more specifically that the "means for determining" constitutes software (see remarks on page 16 in lines 1-2 of page 16), raises the question whether the means for determining is useful without associating it with a computer to provide a tangible result. This means could as well be performed mentally or on paper. The same argument applies to the "means for performing", or the "means for notifying".

Regarding claims 10-22, the claims depend from claim 9 and therefore do not comply with the enablement requirement.

Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, it is unclear whether the step of providing delivery of the commodity will occur since delivery has already occurred in a previous --trial-- purchase of the user according to the first step of claim 2.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Garg et al., 6,571,216.

Regarding claim 1, Garg et al. disclose, in Figure 2, a method of trial purchase, the method includes:

display information of a commodity (free samples; col. 3, line 37) provided from a commodity providing means (web site) on one terminal (col. 3, lines 24-26; col. 5, lines 60-63) for a user; ;

determine whether or not an user has already performed a trial purchase procedure (equipment 206 logs an user profile, and the reward offered at a specific date and time; the equipment 206 also checks whether a trial purchase has been done);

if determination is "no", perform, for the user using the terminal, the trial purchase procedure (it is evident that since no record of a user using the trial purchase for the first time has been made, the user can perform a trial purchase); and,

if determination is "yes", notify the user, at the terminal, that the trial purchase procedure cannot be provided (it is inherit that the trial purchase will not be performed when the agent 103 receives a negative response and so a free sample, "freebies", will not be given; col. 12, lines 24-32).

Regarding claim 2, the method further includes:

store a delivery destination in a previous --trial-- purchase of the user (an address is stored on the server when the user enrolls to get trial purchases, an user profile is created; col. 7, line 18-22); and,

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provide delivery of the commodity to the destination (it is clear that the freebie or the freebies are delivered to the address).

Regarding claim 3, the method further includes:

store a delivery destination in a previous purchase of the user (col. 10, lines 16-23),

display the destination on the terminals when the commodity is specified on the terminal (it is known to display a delivery address on a terminal by either a confirmation page); and,

designate the destination as a destination of the commodity.

Regarding claims 5-7, the commodity (free samples, "freebies" are free of charge) is free of charge.

Regarding claims 9-22 and 33, given the method described by Garg et al., above, the trial purchase system is inherently constructed.

Regarding claim 9, Garg et al. disclose a trial purchase system comprising terminals **104₁**, **104₂**, a commodity providing means (a web site), a network (an internet), a means for determining whether or not an user has already performed a trial purchase procedure (software that checks database **207**, a means for performing (a mouse) for the user using one terminal, if determination is "no", the purchase procedure, and

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means for notifying (a modem) the user at the terminal, if the determination is "yes", the trial purchase procedure cannot be provided.

Regarding claim 10, the commodity providing means includes means (it is well known that databases serve to store commodity information, customer information, etc.) for storing a delivery destination of a previous purchase of the user and providing delivery of the commodity to the destination when the commodity is specified on the terminal.

Regarding claim 11, the commodity providing means includes means for storing a delivery destination of a previous purchase of the user and providing delivery of the commodity to a new designated destination when the commodity is specified on the terminal and the new destination is designated therefor.

Regarding claim 12, the commodity providing means includes means **207** for storing the new designated destination (**207**).

Regarding claims 13-15, the system further includes customer information storing means **207** for storing information on the destinations.

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Regarding claims 16-22, the system further comprises commodity information storing means (hard drive). The commodity information storing means is for storing information on the commodity.

Regarding claim 33, the commodity providing means includes means (it is well known that servers server to deliver software goods to a customer) for providing said commodity for trial purchase at no charge.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garg et al., 6,571,216, in view of startsampling.com's publication.

Regarding claim 4, Garg et al. do not disclose the method further includes:
storing a newly designated destination as there is no indication that Garg et al. disclose designating a newly designated destination. Startsampling.com publication teaches a customer able to update account information, which includes an address

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change. After a customer updates the new information, the server stores a newly designated destination so that the product gets deliver at the customer's new address. Therefore, a web site wanting to provide customers the ability to update a destination as a step for a customer to upgrade shipping delivery information will be motivated to serve the customer's needs. Therefore, as taught by startsampling.com's publication, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store a newly designated destination as a result of a customer wanting to update account information so that the product gets deliver to the right location.

Regarding claim 8, Garg et al. disclose the commodity (free samples, "freebies" are free of charge) is free of charge.

Response to Arguments

Applicant's arguments filed August 31, 2004 have been fully considered but they are not persuasive.

Applicant has argued that Garg et al. disclose a free sample in responsive to the system's assessment of a "user profile" instead of being responsive to purchasing selections made by the user. In response to applicant's argument, it is noted that the features upon which applicant relies (i.e., the trial purchase is responsive to purchasing selections made by the user, or the user makes purchasing selections) are not recited in

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the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has further argued that Garg et al. fail to disclose "trial purchase" as claimed. In response, there is nothing in the claims that define what a trial purchase comprises of. As far as the steps are concerned, the commodity is just obtained free. Users pretend to be buying the commodity and not be billed. Thus, the users get a free commodity.

Applicant further argued that Garg et al. fail to condition a further "trial purchase" on lack of past participation of the user in a "trial purchase". Applicant is reminded that the conditioning is inherent. If no user has ever used Garg et al. system, it is evident that no participation ever occurred. Thus, the user gets a freebie on registration. Furthermore, applicant elaborates in that Garg's logs of past rewards offered are discussed in terms of proof of a valid user transaction. Although true, logs of past reward are also discussed in other terms. The terms would be on the user profile, the reward that was offered, the date and time of a transaction (see col. 7, lines 18-20). Therefore, a merchant offering a freebie every time a user visited the website can be a condition the user has to meet, or alternatively, when users have been notified by email (see col. 7, lines 52-55) the condition is to visit the merchant's website to obtain freebies.

In regards to claim 4 and 8, applicant has argued that the StartSampling.com fails to supply "limit further use of the purchase procedure" and thus Garg et al. fail to provide "a trial purchase". In response, applicant is reminded that the 103 rejection is the combination of Garg et al. in view of StartSampling.com publication since Garg et al. fail to teach storing a newly designated destination as there is no indication that Garg et al. disclose designating a newly designated destination. StartSampling.com is not used to teach "limiting further use of the purchase procedure" as Garg et al. teach this limitation. Applicant is reminded that Garg et al. use the logs to find out whether the user has qualified to receive a second freebie or for that matter one freebie. StartSampling.com is merely teaching what Garg et al. fails to teach, i.e., store a newly designated destination for delivery of a commodity.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

November 23, 2004



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